

REMARKS

Entry of the foregoing, reexamination and reconsideration of the subject application, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested in light of the remarks which follow.

Response to Claim Rejections Under 35 U.S.C. § 103(a)

A. At pages 3-12 of the Office Action, claims 1-3, 5, 6, 12, 13, 16-20, 62, 64, and 65 have been rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over Thomson (2001) when taken with Thomson (1998) as evidenced by Stem Information (National Institutes of Health) when taken with Rijinders et al. and in further view of Lanzendorf et al. when taken with U.S. Patent No. 6,875,607.

B. At pages 12-13 of the Office Action, claims 4, 9, 10, 60 and 61 have been rejected under 35 U.S.C. § 102(a) as purportedly being unpatentable over Thomson (2001) when taken with Thomson (1998) when taken with Rijinders et al., Lanzendorf et al. in further view of U.S. Patent No. 6,875,607, and further in view of Marshall et al. (Methods in Molecular Biology: Isolation and Maintenance of Primate Embryonic Stem Cells 158:11-18, January 2001).

C. At pages 14-15 of the Office Action, claim 11 has been rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over Thomson (2001) when taken with Thomson (1998) when taken with Rijinders et al., Lanzendorf et al. and in further view of U.S. Patent No. 6,875,607, and further in view of Conner.

D. At pages 15-16 of the Office Action, claims 14-15 have been rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over Thomson (2001) when taken with Thomson (1998) when taken with Rijinders et al., Lanzendorf et al., and further in view of U.S. Patent No. 6,875,607, and in further view of Gardner et al. (1998), when taken with Gardner (1999).

E. At pages 16-17 of the Office Action, claim 35 stands rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over Thomson (U.S. Patent No. 6,200,806) when taken with Stratagene Catalog, 1988, p. 39.

These rejections are respectfully traversed.

In the rejections, the Examiner has stated that the present claims are obvious over the combination of Thomson 2001, Thomson 1998, Stem Information (NIH), Rijinders et al.

1998, Lanzendorf et al. 2001, and U.S. Patent No. 6,875,607. The Examiner has further stated that the Thomson 1998 and the '607 patent provide evidence demonstrating that the methods described in Thomson 2001 would result in the isolation of hES cells from human blastocysts, and further refers to the '607 patent for ES cell isolation techniques (see page 7 of the Office Action).

Applicants respectfully disagree with the Examiner's conclusions. Regarding mechanical isolation techniques, in contrast to the present application neither the Thomson patents, the newly added '607 reference, nor any of the additional references cited by the Examiner disclose a method in which immuno-surgery is omitted. On the contrary, all of the referenced papers disclose an immuno-surgical removal of the trophectoderm as a methodological step preceding mechanical isolation of the inner cell mass (ICM).

Applicants note that passaging (not isolation of the ICM) by mechanical dissection without enzymatic treatment is described in '607. But as this method relates to the passaging and not the ICM-isolation step, it is respectfully submitted that the teachings in '607 do not describe the establishment method as recited in the present claims.

Applicants further note that the present method unexpectedly provides a significantly improved cell-line recovery rates as compared to conventional (i.e. immunosurgical) methods.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

CONCLUSION


In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited.

In the event that there are any questions relating to this Amendment and Reply or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney so that prosecution of this application may be expedited.

Respectfully submitted,

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